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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,146	10/15/2001	Max Landes		4272

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KEIL & WEINKAUF
1350 CONNECTICUT AVENUE, N.W.
WASHINGTON, DC 20036

EXAMINER

CLARDY, S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 06/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/977,146

Applicant(s)

Landes

Examiner

S. Mark Clardy

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 18, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-18 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/043,314.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other: |

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Claims 2-18 are pending in this application which is a divisional of SN 09/520,224, now US Patent 6,362,133, which is a divisional of SN 09/043,314, now US Patent 6,054,410, which was filed under 35 USC 371 as a national stage application of PCT/EP96/03996, filed December 9, 1996. The parent US and PCT applications were subject to a finding of a lack unity of invention under 37 CFR 1.475 (MPEP 1850, 1893.03(d)). Claim 1 was canceled, and claims 14-18 were added in Preliminary Amendment A. The preliminary amendment has been entered.

Claims in the parent patents are drawn to synergistic sulfonylurea herbicide compositions comprising an aryloxyalkanoic acid herbicide, e.g., 2,4-D, 2,4-DB, dichlorprop, fluoroxypyr, MCPA, mecoprop ('410 patent); or a herbicide selected from the amides, benzoic acids, benzothiadiazinones, bleachers, ureas, phenols, phenoxyphenoxypropionates, protoporphyrinogen oxidase inhibitors, sulfonylureas, or triazines ('133 patent).

Applicants' claims are drawn to synergistic herbicidal compositions and methods of use comprising a sulfonylurea herbicide and at least one additional secondary herbicide selected from an extensive list (independent claim 14). There is no overlap with the parent patents for the (b) components.

Applicants have elected the species comprising (see claim 4):

- 1) tritosulfuron¹ (compound 47, page 11)
- 2) glyphosate (class b3 herbicide).

¹CA RN: 142469-14-5; 1-[4-methoxy-6-(trifluoromethyl)-1,3,5-triazin-2-yl]-3-[2-(trifluoromethyl)-benzenesulfonyl]urea

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Applicants stated in the response that “applicants’ invention resides in the combination of synergistically effective amounts of constituents (a) and (b). In the particular context of applicants’ invention, the compounds enumerated in the definition of (b) can, therefore, be considered as analogues” (pages 2-3). Thus, it appears that the (b) constituents may be taken as obvious variants of each other.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 5-18 are rejected under 35 U.S.C. 102(a), (b), and (e) as being anticipated by either Beestman (US 5,569,639) OR Hacker et al (US 5,599,769).

Beestman teaches dry flowable agricultural compositions comprising glyphosate in combination with a sulfonylurea herbicide.

Hacker et al teaches synergistic combinations of glyphosate with sulfonylurea herbicides.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Beestman and Hacker et al.

Both references teach the combination of glyphosate with sulfonylurea herbicides. Tritosulfuron is not disclosed, nor are fluoroalkyl substituted rings in the sulfonylurea herbicide explicitly disclosed, although the ring components may be substituted with halogen containing groups (haloalkyl or haloalkoxy for X or Y in Beestman; haloalkoxy for R³ or R⁴ in Hacker et al).

One of ordinary skill in the art would be motivated to combine these references because they both disclose the utility of combining glyphosate with sulfonylurea herbicides.

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Thus it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have combined glyphosate with tritosulfuron or another sulfonylurea herbicide because the prior art teaches that the combination glyphosate + sulfonylurea herbicides was known, and that such combinations were synergistic (Hacker et al). Absent unexpected results for applicants' combination of glyphosate and sulfonylurea herbicides such as tritosulfuron, applicants are seen as having done nothing more than what has been taught in the prior art.

No data has been presented; no unobvious or unexpected results are noted.

No claim is allowed.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103c and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Mark Clardy whose telephone number is (703) 308-4550.



S. Mark Clardy
Primary Examiner
AU 1616

June 25, 2003